

Remarks

I. General

Claims 1, 3-29, 31-33, and 35-37 are pending in this application. Claims 20-29, 35, and 37 are allowed; claims 1, 3-19, and 31 are rejected; and claims 32, 33, and 36 are objected to. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1, 3-19, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,024,680 to Howard (hereinafter "Howard"). Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein.

II. Rejections Under 35 U.S.C. 112

Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, the Examiner rejects claims 14 and 15 as "said desired RF transmission" does not have antecedent basis in the claims. Please note that claims 14 and 15 have been amended only for the purpose of correcting this informality. The claims, however, have not been amended in the face of prior art.

III. Rejections Under 35 U.S.C. 102(e)

Claims 1, 3-19, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Howard.

Applicant submits that the Examiner has failed to establish Howard as prior art to the present application under 35 U.S.C. § 102(e). The present application has a filing date of April 26, 2001. Howard is a U.S. patent having a filing date of November 16, 2001, which claims the benefit of a provisional patent application having a filing date of November 16, 2000. In rejecting the claims, the Examiner relies upon the provisional patent application date as the § 102(e) date of Howard. However, the Examiner does not show where the subject matter of Howard relied upon for rejecting the claims is supported in the provisional application. This is inconsistent with patent examining guidelines, which require "a patent issued from [a provisional application] would be accorded the prior application's filing date

as its 102(e) prior art date assuming that the prior application provides proper support for the relied upon subject matter.” *See Examination Guidelines for 35 U.S.C. § 102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. § 102(g) (see e.g., Section IV “Examination Procedures under 35 U.S.C. §§ 102(e) and 374” thereof).*

In view of the above, Applicant respectfully submits that only the subject matter actually present in the provisional patent application is afforded the earlier date of November 16, 2000. For instance, Howard, which has a filing date of November 16, 2001, may have matter included therein that was not present in the provisional patent application. Such new matter is not afforded the benefit of the filing date of the provisional patent application. Also, *see* M.P.E.P. § 201.11, which explains there are six conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e). The first requirement is that the “second application must be an application for a patent for an invention which is also disclosed in the first application (e.g., the provisional application); the disclosure of the invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112.” *See* M.P.E.P. § 201.11, citing *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994).

In the Current Action, the Examiner has failed to provide Applicant with a copy of the provisional patent application and has failed to identify portions of such provisional patent application that include the teachings relied upon by the Examiner in making the rejections under 35 U.S.C. § 102(e). As such, Applicant is unable to evaluate whether the teaching of Howard relied upon by the Examiner is actually prior art under 35 U.S.C. § 102(e), because such teaching of Howard may not actually be present in the provisional but may instead be newly added matter in the U.S. Patent (and therefore not be afforded the benefit of the provisional application’s filing date). Therefore, Applicant respectfully requests that the Examiner, in a subsequent non-final action, provide a copy of the provisional application and identify the portions of such provisional application that provide the teachings relied upon by the Examiner in making the above 35 U.S.C. § 102(e) rejection. This, of course, is required to give Applicant a full and fair opportunity to respond to the rejection of record.

IV. Conclusion

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 68144/P001US/10500783 from which the undersigned is authorized to draw.

Dated: September 22, 2006

Respectfully submitted,

By R. Ross Viguet

R. Ross Viguet
Registration No.: 42,203
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8185
(214) 855-8200 (Fax)
Attorney for Applicant